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V.S.

SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
08/833,620	04/07/97	DOBBINS M	15275/8610(D

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EXAMINER	
HOFFMANN, J	
ART UNIT	PAPER NUMBER
1731	21

DATE MAILED: 12/03/99

Below is a communication from the EXAMINER in charge of this application

COMMISSIONER OF PATENTS AND TRADEMARKS

ADVISORY ACTION

☒ THE PERIOD FOR RESPONSE:

a) ☐ is extended to run _____ or continues to run _____ from the date of the final rejection

b) ☐ expires three months from the date of the final rejection or as of the mailing date of this Advisory Action, whichever is later. In no event however, will the statutory period for the response expire later than six months from the date of the final rejection.

Any extension of time must be obtained by filing a petition under 37 CFR 1.136(a), the proposed response and the appropriate fee. The date on which the response, the petition , and the fee have been filed is the date of the response and also the date for the purposes of determining the period of extension and the corresponding amount of the fee. Any extension fee pursuant to 37 CFR 1.17 will be calculated from the date of the originally set shortened statutory period for response or as set forth in b) above.

☒ Appellant's Brief is due in accordance with 37 CFR 1.192(a).

☒ Applicant's response to the final rejection, filed 29Nov1999 has been considered with the following effect, but it is not deemed to place the application in condition for allowance:

1. ☒ The proposed amendments to the claim and /or specification will not be entered and the final rejection stands because:

a. ☐ There is no convincing showing under 37 CFR 1.116(b) why the proposed amendment is necessary and was not earlier presented.

b. ☐ They raise new issues that would require further consideration and/or search. (See Note).

c. ☐ They raise the issue of new matter. (See Note).

d. ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal.

e. ☐ They present additional claims without cancelling a corresponding number of finally rejected claims.

NOTE: _____

2. ☐ Newly proposed or amended claims _____ would be allowed if submitted in a separately filed amendment cancelling the non-allowable claims.

3. ☒ Upon the filing an appeal, the proposed amendment ☒ will be entered ☐ will not be entered and the status of the claims will be as follows:

Claims allowed: 12,13,16,22

Claims objected to: _____

Claims rejected: 1,4-6,7,10-11,17,20-21,23,26-27&30

However;

☐ Applicant's response has overcome the following rejection(s): _____

4. ☒ The affidavit, exhibit or request for reconsideration has been considered but does not overcome the rejection because the Affidavit was Not Considered. No Assertion of unexpected results is in the Spec. No evidence of unexpected results.

5. ☒ The affidavit or exhibit will not be considered because applicant has not shown good and sufficent reasons why it was not earlier presented.

☐ The proposed drawing correction ☐ has ☐ has not been approved by the examiner.

☐ Other

JOHN 12-?

PTOL-303 (REV. 5-89)

Response to Arguments

It is argued that Schwarz's "pyrogenic silicic acid" is chemically different from SiO2. Examiner is not convinced. First, it is noted that page 4, lines 12-13 seem to indicate that "the resultant silicic acid" is SiO2. Second, Applicant's Hackh's dictionary indicates that the acid is merely SiO2 which is hydrated. Third, one of ordinary skill would recognize Applicant's example 4's treatment of the soot body with chlorine is performed to dehydrate Applicant's glass, i.e. Applicant's silica is hydrated. Fourth, Applicant does the same thing that Schwarz does - oxidizes a siloxane in a flame, thus one should expect the same end product. Fifth, and most importantly, Schwarz is merely cited as evidence that the claimed siloxane is known. The combination suggested by Applicant was not used by the Office. Schwarz supplies all motivation for using any known siloxane. What Schwarz's final product is, is largely irrelevant.

It is argued that since the filed PTO 1449 was not fully complete is irrelevant as to whether the finality of the Office action is proper. 37 CFR 1.98 (b) requires that all listed foreign patents "shall be identified by...the publication date indicated on the patent..." MPEP 609 C(1) is quite clear that Office will not consider information disclosure statements not in compliance with 37 CFR 1.98. MPEP 609 also states that the date of filing a new or corrected IDS "will be the date of the statement for purposes of determining compliance with the requirements based on the time of filing the statement." Therefore, it was proper for Examiner to consider the references after the first office action and to make the next Office action FINAL based on the information disclosure statement of 3 February 1999. It would be inappropriate and a dereliction of duty for Examiner to not fully enforce the requirements of 37 CFR 1.98.

JOHN HOFFMANN
PRIMARY EXAMINER
GROUP 1300

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